

## **REMARKS**

By this Amendment, claim 22 is cancelled, claims 1, 5, 19-21, 23-25, 27, 34, 42, 47, 59, and 61 are amended, and claims 69-96 are newly added. Consequently, claims 1-8, 10-21, 23-54, and 56-96 are pending in this application, with claims 1, 19, 34, 47, 59, 69, 83, and 87 being independent. Support for the new claims can be found in the originally filed specification, drawings, and claims.

As an initial matter, Applicant wishes to express sincere appreciation to the Examiner for the courtesy extended to Applicant's representative during the personal interview held on November 1, 2005. At the interview, various rejections outstanding in the August 23, 2005 Office Action were discussed. The following remarks reflect subject matter discussed during the interview.

As another initial matter, Applicant respectfully notes that the Office Action lacks a clear indication of the status of claim 57. In particular, although claim 57 was indicated as being rejected in the Office Action Summary (i.e., item 6), that claim was not subject to any rejections in the Office Action. During the interview, Applicant's representative brought this inconsistency to the Examiner's attention. Applicant respectfully requests that the Examiner clarify this inconsistency in the next Office communication to Applicant.

For the following reasons, Applicant respectfully requests withdrawal of all the rejections outstanding in the August 23, 2005 Office Action and allowance of all the pending claims.

### **35 U.S.C. § 102(b) Rejection**

Claims 1-4, 8, 9-18, 22-30, 33-40, 42-44, 46-52, 54, 56, 58-63, and 65-68 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,682,599 to Konomura ("Konomura"). Applicant respectfully requests reconsideration and withdrawal of this rejection.

Konomura discloses a basket forceps assembly 1 comprising a flexible hollow sheath 2 and a basket 3 disposed to be movable out of and into the front end of the sheath 2 for holding or fracturing a foreign matter. The basket 3 comprises a plurality of resilient wires 6 and a front end tip 7 to which the front ends of the individual resilient wires 6 are secured. The front end tip 7 includes a notched groove 18, as shown in Fig. 3, or through openings 19a, 19b, as shown in Fig. 5. In alternative embodiments shown in Figs. 6-9, the sheath 2 includes an opening 20 or elongated slot 21, 22.

During the interview, Applicant's representative proposed the foregoing amendments to each of independent claims 1, 34, 47, and 59. In response, the Examiner indicated that those amendments appear to distinguish over the prior art of record. See Interview Summary dated November 1, 2005. To reiterate, amended independent claims 1, 34, 47, and 59 each recite, among other things, "a tissue cutting end effector" that severs tissue. However, Konomura does not disclose or otherwise suggest the recited "tissue cutting end effector." Instead, as discussed above, Konomura discloses a basket forceps not configured to sever tissue.

For at least these reasons, independent claims 1, 34, 47, and 59, and their respective dependent claims, patentably distinguish from Konomura. Thus, Applicant

respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 102(b) rejection based on Konomura.

### **35 U.S.C. § 103(a) Rejection**

Claims 5-7, 19-21, 31, 32, 41, 45, 53, and 64 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Konomura in view of one of the following secondary references: U.S. Patent No. 5,599,324 to McAlister et al. ("McAlister"); U.S. Patent No. 5,947,978 to Holsinger ("Holsinger"); and U.S. Patent No. 5,575,694 to Hawkins et al. ("Hawkins"). Each of these rejected claims depends directly or indirectly from one of independent claims 1, 34, 47, and 59. At least by virtue of their respective dependency from allowable claim 1, 34, 47, or 59, these dependent claims should also be allowable.

### **New Independent Claim 19 and Dependent Claims 20 and 21**

At the interview, Applicant presented dependent claim 19 in independent form. Independent claim 19 recites a medical device comprising, among other things, "an elongated member having a proximal end, a distal end, and a lumen therebetween," "an end effector proximate the distal end of the elongated member," and "a distal member configured to open and substantially close the distal end of the lumen ..., wherein the distal member fixedly connects to the end effector at a proximal end of the end effector."

In the Office Action, dependent claim 19 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Konomura in view of Holsinger. Although the Office Action admits that Konomura does not disclose "the distal member connected to the proximal end of the end effector," the Office Action alleges that "Holsinger teach[es] of an analogous device having a distal member 30 fixedly secured to the actuator 18 and free

end 32 for insertion into a patient having flanges 74 to secure the distal member to the elongated member (see Fig. 12)” and that “[i]t would have been obvious ... to include a fixedly secured distal member in the apparatus of Konomura in order to prevent objects and fluids from entering the lumen, as taught by Holsinger.

Applicant respectfully disagrees with the reasoning provided in the Office Action. In particular, contrary to the Office Action’s allegation, Holsinger does not teach or otherwise suggest a distal member connected to a proximal end of an end effector. Holsinger discloses a surgical combination apparatus 10 including an injection needle 12 and a snare 14. The apparatus 10 comprises a sheathing means 16 for sheathing the needle 12 and the snare 14. The snare 14 and the injection needle 12 are independently movable relative one another within the sheathing means 16. The apparatus 10 also includes an actuator 18 and an enlarged proximal end 30 fixedly secured to the actuator 18.

The Office Action does not specifically identify which element of Holsinger corresponds to the recited “end effector.” Nonetheless, Applicant respectfully submits that, regardless of which element is alleged to correspond to the recited “end effector,” the proximal end 30 of Holsinger cannot correspond to the recited “distal member” because, among other reasons, it does not connect to any end effector. Moreover, the proximal end 30 is not configured to open and substantially close a distal end of a lumen of an elongated member, as recited in claim 19. Instead, the proximal end 30 is merely secured to a distal end of the actuator 18. Therefore, even assuming, *arguendo*, that Holsinger expressly teaches to incorporate its proximal end 30 to the device of

Konomura, one of ordinary skill in the art would not have placed the distal end 30 to a proximal end of the basket forceps of Konomura.

For at least these reasons, independent claim 19 and its dependent claims 20 and 21 patentably distinguish from the alleged combination of Konomura and Holsinger. Thus, reconsideration and withdrawal of this rejection is respectfully requested.

#### **New Independent Claim 69 and Dependent Claims 70-82**

New independent claim 69 recites a medical device comprising, among other things, “an elongated member having a proximal end, a distal end, and a lumen therebetween,” “an end effector proximate the distal end of the elongated member,” and “a distal member ... defining a flow path ..., wherein at least a portion of the flow path has a cross-sectional flow area smaller than both a cross-sectional flow area of an inlet of the flow path and a cross-sectional flow area of an outlet of the flow path.”

As discussed during the interview, none of the cited references including Konomura discloses, among other things, the recited flow path configuration of claim 69. For at least this reason, independent claim 69 and its dependent claims 70-82 patentably distinguish from the cited references.

#### **New Independent Claim 83 and Dependent Claims 84-86**

New independent claim 83 recites a medical device comprising, among other things, “an elongated member having a proximal end, a distal end, and a lumen therebetween,” “an end effector proximate the distal end of the elongated member,” and “a distal member ... comprising: a main body connected to a proximal end of the effector; and an annular body fixed to the distal end of the elongated member, wherein

the main body and the annular body are configured to contact each other to substantially close the distal end of the lumen.”

As also discussed during the interview, none of the cited references discloses the recited structural configuration of a main body and an annular body of a distal member. Thus, independent claim 83 and its dependent claims 84-86 patentably distinguish from the cited references.

#### **New Independent Claim 87 and Dependent Claim 88**

New independent claim 87 recites a medical device comprising, among other things, “an elongated member having a proximal end, a distal end, and a lumen therebetween,” “an end effector proximate the distal end of the elongated member,” and “a distal member ... defining a flow path ..., wherein the flow path comprises an inlet and a plurality of outlets connecting to the inlet.”

As also discussed during the interview, none of the cited references discloses the recited flow path configuration of claim 87. Thus, independent claim 87 and its dependent claim 88 patentably distinguish from the cited references.

#### **Conclusion**

Applicant respectfully requests reconsideration of this application, withdrawal of all the outstanding rejections, and allowance of all pending claims.


The Office Action contains a number of statements and characterizations regarding the claims and the related art. Applicant declines to necessarily subscribe to any statement or characterization in the Office Action, regardless of whether it is addressed above.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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